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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/124,754	07/29/1998	SHINICHIROU GOTOU	P7439-8005	7056

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ARENT FOX KINTNER PLOTKIN & KAHN
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER

TANG, KENNETH

ART UNIT	PAPER NUMBER
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2127

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/124,754

Applicant(s)

GOTOU ET AL.

Examiner

Kenneth Tang

Art Unit

2127

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirakawa (5,664,126) in view of DeLorme (US Patent Number 5,559,707) and further view of Dunworth (US Patent Number 5,930,474).

2. Referring to claims 1, 6, 11, 13-14, Hirakawa teaches an email system (*electronic mail, col 32, lines 11-17*) comprising:

- Text input means (*text transmission, col 22, lines 37-47*);
- Extracting means (*particular keyword, full text retrieving, col 2, lines 55, and extracted, texts, col. 29, lines 50-54*);
- Adding means (*information added, col 33, lines 34-42, and for example, a message is converted into an electronic mail, col. 5, lines 54-56, and transmission of messages, electronic mails, col. 32, lines 11-17*);
- Text display means (*visualizer, 230, col 11 and col 22*).

Hirakawa fails to explicitly teach a system specifying a place and a map display means.

However, DeLorme teaches the use of a map display for showing map information of a specified

Art Unit: 2127

place (*map display, waypoint, col 35, lines 11-44*). It would have been obvious to one ordinary skill in the art at the time the invention was made to combine a map navigation feature of DeLorme to the system of Hirakawa so that map information can be transmitted and received.

The reference of DeLorme fails to explicitly teach launching a map program for a different user. However, Dunworth teaches user initiation of a regional geographic search from, for example, a personal computer or terminal connected and transmitted through internet connection. Therefore, it would be obvious to one ordinary skill in the art at the time the invention was made to modify the combination system of Hirakawa in view of DeLorme with launching a program through internet connection for a different user of Dunworth, so that map information can be connected and launched by email from one terminal to a different terminal.

3. Referring to claims 2, 5, 7-10, Hirakawa teaches using a transmitter communication terminal for transmitting email (*Figure 24, 530*) and a receiver communication terminal for receiving email (*Figure 24, 540*). Hirakawa also teaches the use of a server (*site server 200*) connected by a communication link (*site handler 240*). It is well known that a server has the capability of storing data - data that could include map information.

4. Referring to claims 3 and 4, DeLorme teaches the use of a route guidance means (*displayed route, col 11, lines 34-50*) and coordinate data (*geographical coordinate system, col 3, lines 11-18*).

Art Unit: 2127

5. Referring to claim 12, Hirakawa teaches an system that can transmit and receive email (*electronic mail, col 32, lines 11-17*).

6. Referring to claim 15, it is rejected for the same reasons as stated in the rejection of claims 1, 6, 11, 13-14 described above.

ARGUMENTS

7. The amended title is appropriate and the objection to the title has been withdrawn.

8. Applicant argues the Patentability of claims by individually addressing the references used to reject the claims. It is noted that the claims above are rejected as being obvious using a combination of the references. Applicant can not show non-obviousness by attacking the references individually where as here the rejections are based on a combination of references, *In re Keller*, 208 USPQ 871 (CCPA 1981). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Bond*, 910 F. 2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (quoting *Carella v. Starlight Archery and Pro Line Co.*, 804 F. 2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)). However, the "suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all the references used to show obviousness." *Cable Elec. Prods., Inc. v. Genmark Inc.*, 770 F. 2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985). Rather the test is whether the combined teachings of the prior art, taken as

Art Unit: 2127

a whole, would have rendered the claimed invention obvious to one of ordinary skill in the art.

See In re Gorman, 933 F. 2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

9. *Applicant argues that the reference of Hirakawa fails to teach an extracting means for extracting a character string to specify a place from the text inputted by the text input means and adding means for adding information to the electronic mail, the information corresponding to the place specified by the extracted character string.* In response, the argument was heavily considered and were found unpersuasive. As stated in the Office Action, Hirakawa teaches an extracting means which extracts a character string ("*full text retrieving*", col 2, lines 55, and "*extracted texts*", col. 29, lines 50-54). This information that is extracted and added to an email that is transmitted and received ("*converted into an electronic mail*", col. 5, lines 54-56). Hirakawa's invention extracts a character string of texts and it is well known that navigation information such as waypoints can also be represented as a character string of texts. In addition, DeLorme also teaches extracting characters that represent points of interest ("*POIs are extracted*", col. 31, line 40). Therefore, combining the email system of Hirakawa to the map navigational system of DeLorme is proper.

10. *Applicant argues that Dunworth fails to disclose that it would be desirable or even possible for one user to conduct a search of the geographically and topically based information and then transmit that information to a second user in an e-mail.* In response, the examiner disagrees. Dunworth discloses on **Table 5** various data fields of the program, which include "Name", "Address", "City", "State", "Zipcode", and "Electronic Mail Address" of the user.

Art Unit: 2127

Therefore, it is shown that it is desirable and possible for the geographically and topically based information to be transmitted through e-mail.

11. Applicant also argues that the combination of the references of Hirakawa, DeLorme, and Dunworth fail to teach and/or suggest a map display means for displaying map information indicating the specified place corresponding to the information added to the electronic mail. In response, the Examiner disagrees. Again, Hirakawa teaches an email system that transmits and receives with text extractions and it is well known that navigation information such as waypoints can also be represented as a character string of texts. DeLorme teaches the use of a map display for showing map information of a specified place (*map display, waypoint, col 35, lines 11-44, and see Fig. 1B*). DeLorme also teaches extracting characters that represent points of interest ("POIs are extracted", *col. 31, line 40*). Dunworth discloses that it is desirable and even possible for one user to conduct a search of the geographically and topically based information and then transmit that information to a second user in an e-mail (*see Table 5*).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2127

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth Tang whose telephone number is (703) 305-5334. The examiner can normally be reached on 8:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

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December 4, 2002



JOHN A. FOLLANSBEE
PRIMARY EXAMINER